REMARKS/ARGUMENTS

On February 12, 2007 Applicant filed a response to the prior office action dated October 11, 2006, which was understood to be a final office action. The current Office Action mailed March 23, 2007 clarifies that the prior office action of October 11, 2006 was intended to be non-final and resets the period for response to that non-final office action to run from the new date of mailing (i.e., March 23, 2007). The objections and grounds for rejection set forth in the March 23, 2007 Office Action are the same as set forth in the prior office action dated October 11, 2006. Thus, Applicant is proceeding on the understanding that the amendment filed on February 12, 2007 has not been entered and that the current Office Action is non-final.

Applicant hereby response to the non-final office action of March 23, 2007 as follows:

Amendments to the Specification

The foregoing amendment to the specification corrects typographical errors and clarifies the chain of priority claimed. No amendments have been made to the claims in this paper. As discussed herebelow, reconsideration of the grounds for rejection stated in the final Office Action is respectfully requested.

Priority Claim To Parent Application 08/837,294

This application was filed on July 24, 2001 as a division of United States Patent Application 08/837,294 which was filed April 11, 1997 and which became issued as United States Patent No. 6,302,875 on October 16, 2001. Applicant's intention for this application to be a division of Serial No. 08/837,294 is reflected on page one of the document entitled Transmittal of a Divisional Utility Patent Application which accompanied the filing of this application. A true and exact excerpt of this language from page 1 of the Transmittal of a Divisional Utility Patent Application is reproduced herebelow:

> [X] The applicant(s) hereby request(s) the filing of the divisional patent application under 37 CFR §1.60, corresponding to co-pending application Serial No. 08/837,294.

Elsewhere in the Transmittal of a Divisional Utility Patent Application paper, it was erroneously indicated that this application was a "division" of not only Parent Application

08/837,294, as intended, but also two other applications, namely 08/730,327 and 08/730,496. As a result, the official filing receipt correctly indicates that this application is a division of Parent Application 08/837,294, as intended. However, the official filing receipt also erroneously indicates that this application is also a division of 08/730,327 and 08/730,496. A true and exact excerpt of this language from the official filing receipt is reproduced herebelow:

Domestic Priority data as claimed by applicant

THIS APPLICATION IS A DIV OF 08/730,327 10/11/1996 PAT 6,190,353
AND A DIV OF 08/730,496 10/11/1996 PAT 5,830,222
AND A DIV OF 08/837,294 04/11/1997

Thus, the required claim of priority to Parent Application 08/837,294 was included in the application transmittal papers and the information containing this claim of priority to Parent Application 08/837,294 was included in the official filing receipt. Therefore, the claim of priority to Parent Application 08/837,294 was timely made.

The foregoing amendment to the specification merely corrects typographical errors, eliminates duplicative language and clarifies the chain of priority that precedes Parent Application 08/837,294. Since the claim to Parent Application 08/837,294 was properly made in the transmittal papers that accompanies this divisional application and is shown on the official filing receipt, no petition under 37 C.F.R. §1.78(a) or surcharge under 37 C.F.R. 1.17(t) are required.

Accordingly, it is respectfully submitted that the requirements of 37 U.S.C. §1.78(a) have been met.

35 U.S.C. §102 Rejections

In the Office Action, independent claim 53 was rejected over Lary et al. Applicant again traverses this rejection.

As explained above, the priority claim to Parent Application Serial No. 08/837,294 was timely made and the requirements of 37 U.S.C. §1.78(a) have been met. Parent Application 08/837,294 itself is a is a continuation-in-part of and incorporates by reference Serial No. 08/730,327 filed Oct. 11, 1996 (US Patent No. 6,190,353) which further claims

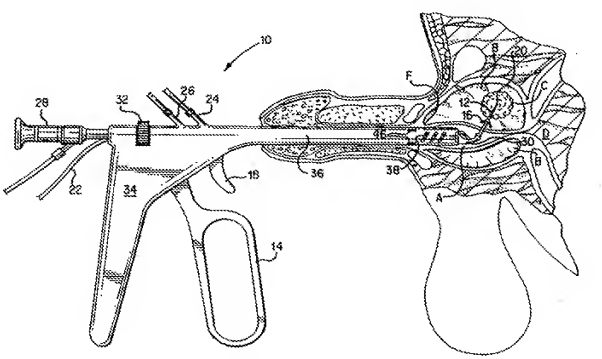
priority to and incorporates both United States Provisional Application Serial Nos. 60/005,164 filed Oct. 13, 1995 and 60/010,614 filed Feb. 2, 1996. Parent Application Serial No. 837,294 is also a continuation-in-part of and 08/730,496 filed Oct. 11, 1996 (US Patent No. 60/005,164) which also claims priority to United States Provisional Application Serial Nos. 60/005,164 filed Oct. 13, 1995.

Claim 53 is fully supported and enabled by the subject matter of both 60/005,164 filed Oct. 13, 1995 and 60/010,614 filed Feb. 2, 1996. Both of these provisional applications were filed prior to the October 3, 1996 filing date of Lary et al. Thus, Lary et al. is not prior art to claim 53 and withdrawal of the stated rejection over Lary et al. is requested.

35 U.S.C. §103 Rejections

Also in the office action, all claims were rejected as being obvious over Makower in view of Murphy-Chutorian. In explaining this rejection, the Office Action notes that Makower does not disclose a guidewire as required in claim 53. However, the Office Action states that it would have been obvious to "replace the fiber of Makower with the fiber-guidewire bundle of Murphy-Chutorian to obtain better control of the placement of the fiber with respect to the predetermined tissue site."

For convenience, Makower's Figure 1 is reproduced hereblow:



The Makower device has a rigid shaft 36 that is inserted transluminally into the urethra. Hand lever 14 is squeezed to cause a locking cannula 12 (which has the sharpened distal tip

20 of a laser fiber extending out of its distal end) to advance through the urethral wall and into the prostate. The cannula 12 itself does not penetrate through tissue and Makower contains no teaching of the distal tip of cannula 12 being sharp or capable of penetrating through tissue. Rather, it is the protruding sharpened distal tip 20 of the laser fiber (or alternatively a sharp stylet inserted through the cannula) that penetrates through the urethral wall and into the prostate (see, page 9, lines 16-20). Thereafter, locking means 16 is deployed by pressing trigger 18, this anchoring the cannula 12 in place. Laser energy is then applied through the laser fiber to effect treatment of the prostate tissue.

Also, contrary to what is stated in the Office Action, Murphy-Chutorian does not mention, describe or even remotely suggest any "fiber-guidewire bundle" or anything else bundled with a "guidewire." Rather, Murphy-Chutorian describes a "laser delivery fiber bundle" which is used to deliver laser energy. In some embodiments, this laser delivery fiber bundle may include a spring member (354) that is bundled within the fiber matrix. However, disclosure of a "spring member" is not enabling disclosure of a "guidewire." Murphy-Chutorian clearly does not mention, describe or even remotely suggest any bundling or inclusion of any guidewire with the optical fibers. Nor does Murphy-Chutorian describe or suggest any way in which this laser delivery fiber bundle could function or be used as a guidewire or any reason why one would be motivated to use this optical fiber bundle as a guidewire.

Moreover, contrary to what is stated on page 5 of the Office Action, Makower does not describe any device having an "elongate flexible catheter body that is advanceable through the vasculature into said blood vessel lumen, said catheter body having a side wall and at least one lumen extending longitudinally therethrough" and "an opening formed in the side wall of said catheter body" as required by independent claim 53. In this regard, it is respectfully submitted that the Examiner may be confusing the "shaft" 36 of the Makower device with the flexible cannula 12 that advances into the prostate. Applicant respectfully asks the Examiner to note, the Makower et al. device has a rigid shaft 36 that is advanced transluminally into the urethra. The Office Action states that Makower states on pages 2 and 11 that the "cannula" can be at least partially flexible. However, Applicant has never

contended otherwise. Applicant recognizes that the cannula 12 of the Makower device is at least partially flexible. However, the transluminally inserted shaft 36 of the device is rigid and Makower contains no teaching of any portion of that shaft 36 being flexible. This rigid shaft clearly does not constitute a "flexible catheter body that is advanceable through the vasculature" as required by independent claim 53.

Although Makower's Figure 11 does appear to show an embodiment of the device where a side opening is formed in the shaft 36, such shaft still remains rigid. Nothing in Makower et al. describes or suggests any motivation to modify the rigid shaft 36 to make it flexible.

Moreover, Makower does not describe any procedure or situation wherein it would be desirable to introduce a guidewire through the cannula 12. Nor does Makower describe any procedure or situation where some other apparatus could later be advanced over a guidewire that has been advanced into the prostate through cannula 12. Since Makower does not describe or mention any reason why anyone would want to advance anything over a guidewire that has been inserted into the prostate through cannula 12, there would be absolutely no motivation for anyone to replace the laser fiber 20 with a guidewire. Furthermore, it is well known that guidewires do not function as laser light guides. Since the only function of the laser fiber 20 is to deliver laser energy into the prostate, replacement of the laser fiber 20 with a guidewire would render the Makower device inoperative an unuseable for its intended purpose.

Thus, for at least the reasons stated above and possibly others not specifically articulated here, independent claim 63 is patentably distinguishable over Makower and Murphy-Chutorian as well as all other prior art of record. Additinally, because dependent claims 54-63 further limit the novel and unobvious subject matter of claim 53, claims 54-63 are also allowable for at least the same reasons stated with respect to claim 53. Applicant reserves the right to separately argue the allowbility of each dependent claim in a later-filed appeal brief in the event the stated rejections are not withdrawn.

CONCLUSION

For the foregoing reasons, Applicant believes all the pending claims are in condition for allowance and should be passed to issue. The Commissioner is hereby authorized to charge any additional fees which may be required under 37 C.F.R. 1.17, or credit any overpayment, to Deposit Account No. 01-2525. If the Examiner feels that a telephone conference would in any way expedite the prosecution of the application, please do not hesitate to call the undersigned at telephone (707) 543-5484.

Respectfully submitted,

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